UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,345	11/09/1999	BRANT L. CANDELORE	80398.P215	7843

7590 03/24/2004

JEFFREY S SMITH
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
7TH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES, CA 90025

EXAMINER
FIELDS, COURTNEY D

ART UNIT	PAPER NUMBER
2137	4

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/437,345	CANDELORE, BRANT L.	
	Examin r	Art Unit	
	Courtney D. Fields	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed 12 January 2004 have been fully considered but they are not persuasive.

2. Referring to the rejection of claims 1,23,45, and 50, the Applicant argues that the prior art Wasilewski et al. does not teach receiving a plurality of access requirements, wherein each access requirements can descramble the scrambled program, selecting at least one of the access requirement, and storing the scrambled program, and the selected at least one access requirement, nor describe an "instance service". The Examiner disagrees and asserts that Wasilewski et al. does teach a conditional access system such as a CATV system, which provides its subscribers with information from a number of services. Each program provided by a particular channel is an "instance" of that service (i.e. "instance service"). When the service broadcast the instance, it encrypts or scrambles the instance to form encrypted instance. The encrypted instance contains instance data and entitlement control messages (ECM). ECM is an access requirement containing information needed to decrypt the encrypted portion of the instance data. Therefore, in order to decrypt an instance service which is delivered to the television set (i.e. "set-top box"), the set-top box uses a control word which contains ECMs and authorized information which are stored in the set-top box. The authorized information indicates what programs in the service the subscriber is entitled to watch. As shown in Figure 1, the set-top box stores the following: authorization information, entitlement management messages, entitlement control messages, control word

generator, and a decryptor. Furthermore, in order for control word to be used as a key to decrypt an encrypted instance, ECM and authorized information are used which are located within the set-top box. (See Column 4, lines 17-66)

3. Therefore, the rejection of claims 1-58 are maintained in view of the reasons above and in view of the reasons below.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2,5,23-24,27,45-46,49-51, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasilewski et al. U.S. Patent No. 6,157,719. As per claims 1,23,45, and 50, Wasilewski et al. discloses a method and system for storing scrambled digital programs within a conditional access system comprising: receiving the scrambled program (encrypted instance), receiving a plurality of instance services (access requirement), wherein each instance service can descramble the scrambled program, selecting at least one instance service, and storing the scrambled program and the selected access program (stored in set-top box and ECM) in Column 4, lines 17-63.

As per claims 2,24,46, and 51, Wasilewski et al. discloses the claimed limitation wherein each access requirement is included in a packet identifier (PID) in Column 18, lines 52-60, Column 19, lines 1-25.

As per claims 5,27,49, and 54, Wasilewski et al. discloses the claimed limitation wherein access requirement are selected from a group comprising: pay per view, pay per time, impulse pay per view, personal scrambling, etc. in Column 12, lines 41-67, Column 13, lines 1-2, Column 30, lines 40-67, Column 31, lines 1-10.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3-4,6-9,16-19,22,25-26,28-31,36,38-41,44,47-48,52-53,55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. U.S. Patent No. 6,157,719 in view of Muratani et al. U.S. Patent No. 6,061,451. As per claims 3-4,6-9,16-19,22,25-26,28-31,36,38-41,44,47-48,52-53,55-58, Wasilewski et al. teaches the invention as claimed. However, Wasilewski et al. does not explicitly teach the feature of filtering stream data. As per claims 3,25,47, and 52, Muratani et al. discloses the claimed limitation of filtering the extracted ECM and EMM data from inputted stream data and passing data to an interface Column 2, lines 5-12.

As per claims 4,26,48, and 53, Muratani et al. discloses the claimed limitation wherein the output is delivered to an input of a digital storage medium in Column 2, lines 1-3, 22-30.

As per claims 6,16,28,38,55, and 58, Muratani et al. discloses the claimed limitation of receiving a digital bitstream in a scrambled format, descrambling the digital content in a scrambled format to provide a first output in a descrambled format, re-scrambling the digital content in a descrambled format to provide a second out in a re-scrambled format, outputting the first output (set-top box) in a descrambled format and the second output in a re-scrambled format, receive access requirements, select one of the access requirements, and store the scrambled program and the selected access requirement in Column 6, lines 12-62.

As per claims 7,17,29,39 and 56, Muratani et al. discloses the claimed limitation of receiving and recording the digital content of the second output (DVD interface) in a scrambled format in Column 17, lines 15-55. .

As per claims 8,18,30,40, and 57, Muratani et al. discloses the claimed limitation of demultiplexing the digital content from the program data and decompressing the digital content in a descrambled format in Column 6, lines 3-11, Column 16, lines 4-17.

As per claims 9,19,31, and 41, Muratani et al. et al. discloses the claimed limitation wherein decompressing is executed in an MPEG decoder in Column 2, lines 50-64, Column 6, lines 3-11.

As per claims 14,22,36, and 44, Muratani et al. discloses the claimed limitation of extracting a descrambling key and applying the key to the digital content in a scrambled

format, providing digital content in a descrambled format in Column 9, lines 16-22. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Wasilewski et al.'s conditional access system by combining Murantani et al's receiving and decrypting digital content apparatus.

5. As per claims 10,20,32, and 42, Wasilewski et al. discloses the claimed limitation wherein digital content is contained in digital television transmissions in Column 7, lines 30-47.

As per claims 11,21,33, and 43, Wasilewski et al. discloses the claimed limitation wherein digital content is downloaded from the Internet in Column 7, lines 47-50, Column 45, lines 31-40.

As per claims 12 and 34, Wasilewski et al. discloses the claimed limitation wherein descrambling and re-scrambling steps are carried out in a first conditional access unit (EMM) in Column 8, lines 29-63.

As per claims 13 and 35, Wasilewski et al. discloses the claimed limitation wherein descrambling steps are carried out in a first conditional access unit (EMM) in Column 9, lines 50-55, and re-scrambling steps are carried out in a second conditional access unit (ECM) in Column 8,lines 64-67, Column 9, lines 40-50.

As per claims 15 and 37, Wasilewski et al. discloses the claimed limitation wherein descrambling key is used to re-scramble the digital content in Column 7, lines 7-24.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 703-305-8293. The examiner can normally be reached on Mon - Thu 7:00 - 5:00 pm; off every Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

cdf
March 16, 2004